

REMARKS

Claims 33, 35, 37-42 are in the application.

The claims have been amended to more particularly point out and distinctly claim applicants' invention. Claims 40, 41 and 42 have been amended to remedy a minor indefiniteness issue and to distinguish over the cited art, based on applicant's counsel's helpful discussions with the Examiner. These amendments are fully supported by the application as filed, and present no new matter.

Applicant previously attempted to put the claims in better form for appeal with the filing of the amendment dated November 4, 2009. However, according to the Advisory Action Before the Filing of an Appeal Brief dated November 19, 2009, the Examiner did not enter the claim amendments proposed in Applicant's submission of November 4, 2009.

Applicant gratefully acknowledges the helpful discussions of the claims with Examiners Kim and Wong on December 10, 2009, and the Examiner's generous consideration of Applicant's draft claims on January 12, 2010.

Applicant notes that the Examiner has withdrawn his previous rejections in favor of new grounds of rejection set forth in the current Examiner's Action.

The Examiner has objected to claim 36 on formal grounds. However, claim 36 has been cancelled in favor of new claim 40. Consequently, reconsideration and withdrawal of the objection are respectfully requested.

Indefiniteness Rejection

Claims 40, 41 and 42 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. This rejection is respectfully traversed, and reconsideration and withdrawal of the rejection are respectfully requested as applicable to the presently amended claims.

The Examiner states that regarding claims 40-42, the phrase "the method working in such a way" renders the claim(s) indefinite because the claims include elements not actually disclosed (those encompassed by "the method working in such a way"), thereby rendering the scope of the claim(s) unascertainable, citing See MPEP § 2173.05(d). In particular, the Examiner states that the phrase "the method working in such a way" suggests that other methods or additional steps "work in such a way" so that there is only one last new member of the group at any point in time. The Examiner suggested amending the limitations with more active language to provide more weight to the particular steps within the method claims. The Examiner's suggestion has been adopted by the applicant, and the claims have been amended to make clear how the method works, such that the "second last new member of the group" supersedes "the first last new member of the group" and "the third last new member of the group" supersedes "the second last new member of the group."

Reconsideration and withdrawal of the indefiniteness rejection are respectfully requested for these reasons.

Anticipation Rejection

Claims 33, 35, 37, 38, 40 and 41 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,092,952 ("Wilens"). This rejection is respectfully traversed, and reconsideration and withdrawal of the rejection are respectfully requested as applicable to the amended claims.

Remarks Concerning Claim 40

First, Applicant notes that claim 40 has been amended to require at least three participating persons, as discussed with the Examiner. Thus, Wilens does not meet each

and every limitation of the claim as presently amended, and thus this claim is not anticipated by Wilens.

Regarding Paragraph 2(a) of the rejection entered under 35 U.S.C. 102:

The Office Action states that Wilens discloses "each participating person selecting a set of indications" and "the set of indications consisting only of at least one other participating person that said each participating person wishes to meet."

The applicant respectfully disagrees as follows:

In the claimed invention, the set of indications refer to at least one other participating person that said each participating person wishes to meet. This is expressly stated in step (a) of Claim 40. The applicant wishes to direct the Examiner's attention to the fact that the indication in the claimed invention is actually a person.

Wilens teaches a method of grouping computer subscribers based on common preferences. Figs. 6, 6A – 6E discloses the process followed by a computer subscriber in creating his profile. The profile as described in the above Figures is the subscriber's personal information, relationship preferences, the subscriber's hobbies and his matching preferences and control. Please refer to Column 2 line 66 to Column 3 line 1 and Column 5 line 15 to Column 6 line 28 of Wilens.

It is evident from the above that the profile created by the subscribers in Wilens does not include references to any other person that the subscriber is interested in meeting. The profile only contains the subscriber's personal information. Therefore, Wilens does not disclose the set of indications as disclosed in Claim 40.

Moreover, in the claimed invention, each participating person, by selecting the set of indications, selects at least one other participating person that the former is interested in meeting. Whereas Wilens does not disclose anywhere that the subscriber selects

another subscriber that he is interested in meeting. The subscriber merely creates his profile. Please refer to Figs. 6, 6A to 6E and Column 2 line 66 to Column 3 line 1 of Wilens.

Regarding Paragraph 2(c) of the rejection entered under 35 U.S.C. 102:

The Office Action states that Wilens discloses "processing the set of indications recorded in the database by a computerized system to form the group."

The applicant respectfully disagrees as follows:

Wilens discloses the processing of profile information of the subscribers when the group is formed. Please refer to lines 48 to 54 of Column 6 and block 78 of Fig. 7 of Wilens. Wilens does not disclose any processing of the set of indications, the set of indications being different from the profile information of the subscribers.

Regarding Paragraph 2(c)(i) of the rejection entered under 35 U.S.C. 102:

The Office Action states that Wilens discloses "including as a first member of the group any participating person who has indicated at least one other participating person in the set of indications, thereby becoming a last new member of the group."

The Applicant respectfully disagrees as follows:

Column 5 line 15 to Column 6 line 28 of Wilens discloses the process of entering the profile information by any subscriber. The method disclosed by Wilens groups the subscribers based on their common traits and preferences entered in the profile information. Please refer to the Abstract of Wilens. Wilens does not disclose grouping based on the subscribers intention to meet another subscriber. In the method disclosed by Wilens, the subscribers come to know of each other only after they are included in the group. Nowhere in Wilens does it indicate that a particular subscriber becomes a first member of the group.

This is contrary to the claimed invention wherein the first member of the group is any participating person who has indicated that he wishes to meet one other participating person in his set of indications. This is expressly stated in lines 4 to 5 and lines 9 to 11 of Claim 40. In the claimed invention, the participating person is aware of the other participating person before they are included in the same group. This is not taught by Wilens.

Regarding Paragraph 2(c)(ii) of the rejection entered under 35 U.S.C. 102:

The Office Action states that Wilens discloses "including in the group another participating person indicated in the set of indications of the last new member of the group, said another participating person thereby then becoming the last new member of the group after joining the group, the method working in such a way that there is only one last new member of the group at any point in time."

The applicant respectfully disagrees as follows:

Column 5 line 15 to Column 6 line 28 of Wilens discloses the process of entering the profile information by any subscriber. Wilens discloses a method of grouping computer subscribers by common preferences to establish non-intimate relationships. Please refer to lines 54 to 56 of Column 2 of Wilens.

Wilens does not teach including a new person in the group based on the indications as disclosed in the claimed invention. Hence Wilens does not disclose the claimed invention.

Regarding Paragraph 2(c)(iii) of the rejection entered under 35 U.S.C. 102:

The Office Action states that Wilens discloses "repeatedly including new persons to the group by the above step (ii) until a new person to be included in the group is already included in the group."

The Applicant respectfully disagrees as follows:

Step c(iii) of Claim 40 is for stopping the process of group formation by checking if a new person to be included in the group is already included in the group. Wilens does not disclose such a checking procedure. A multi-way match in Wilens is just to check if the subscriber's preferences are considered from both perspectives – from the perspective of the subscriber and from the perspective of other subscribers. This is totally contrary to step c(iii) of Claim 40.

It is evident from the above that the teachings of Wilens are totally contrary to the teachings of the claimed invention. Hence, Wilens does not disclose the claimed invention. It also does not suggest or motivate a person skilled in the art to lead to the claimed invention.

Remarks Concerning Claims 37 and 38

Again, the Applicant notes that claims 37 and 38 depend from claims 40 and 41 that have been amended to require at least three participating persons, as discussed with the Examiner. Thus, Wilens does not meet each and every limitation of the claim as presently amended, and thus this claim is not anticipated by Wilens.

The Office Action states that Wilens discloses “the set of indications is a list of other participating persons that a participating person wishes to meet.”

The Applicant respectfully disagrees as follows:

In the claimed invention, the set of indications refer to at least one other participating person that said each participating person wishes to meet. This is expressly stated in Claims 37 and 38. The applicant wishes to direct the examiner's attention to the fact that the indication in the claimed invention is actually a person.

Wilens teaches a method of grouping computer subscribers based on common preferences. Figs. 6, 6A – 6E discloses the process followed by a computer subscriber in creating his profile. The profile as described in the above Figures is the subscriber's personal information, relationship preferences, the subscriber's hobbies and his matching preferences and control. Please refer to Column 2 line 66 to Column 3 line 1 and Column 5 line 15 to Column 6 line 28 of Wilens.

It is evident from the above that the profile created by the subscribers in Wilens does not include references to any other person that the subscriber is interested in meeting. The profile only contains the subscriber's personal information. Therefore, Wilens does not disclose or suggest the set of indications as disclosed in Claims 37 and 38.

Therefore, Wilens does not disclose the inventions claimed in Claims 37 and 38. It also does not suggest or motivate a person skilled in the art to lead to the claimed invention.

Consequently, Wilens does not make out a *prima facie* case of either anticipation or obviousness, and reconsideration and withdrawal of this rejection as applicable to the amended claims are respectfully requested for this reason.

Obviousness Rejection

Claims 39 and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wilens in view of U.S. Appl. 2002/0023090 ("McGeachie"). This rejection is also respectfully traversed, and reconsideration and withdrawal of the rejection are respectfully requested as applicable to the amended claims.

The Office Action states that Claims 42 and 39 are obvious in light of the combination of Wilens and McGeachie.

The Applicant respectfully disagrees as follows:

First, Applicant notes that independent claim 42 has been amended to require at least three participating corporations. This is not disclosed or suggested by either of the cited references, nor by the combination of the two.

Further, Wilens discloses a method for grouping computer subscribers based on common preferences. According to Wilens, the subscribers of the system store their profile in the system database. The system groups the subscribers with at least two fellow subscribers to form a group, the grouping based on similarities in the subscribers stored profiles. The subscribers do not know each other and meet each other only after they are included in the group. They do not intend to meet a specific person when they post their profile in the system database.

McGeachie teaches a method of and system for determining connections between a source party and a target party in a transaction. The source party and the target party are represented by databases. The system determines the connection based on common identification information. The identification information may include the person's name, the person's date of employment with a company, the person's company name and address, the person's title within the company etc. The system tries to determine contacts in between the source party and the target party based on commonalities in them.

In short, Wilens teaches to form a group whereas McGeachie teaches to determine the connections between the source party and a target party that are represented by separate databases. It is apparent from the Abstract and Fig. 4 of McGeachie that a multitude of databases are involved, whereas in Wilens the processing of profile information of subscribers for forming a group is carried out within one database

only as indicated in Fig. 2. Accordingly, the technology used in Wilens and McGeachie and the scale of data processing are different from each other. It is evident that the teachings of Wilens and McGeachie have no common objective or purpose. Hence, a person skilled in the art will not be motivated to combine Wilens and McGeachie together and read them.

Secondly, according to Wilens teachings the subscribers do not know each other before becoming a part of the group. They become part of the group based on common preferences in their profiles and then they come to know each other. This is contrary to the teachings of the inventions claimed in Claims 42 and 39, wherein the grouping is based on the set of indications. The set of indication is a reference to another participating corporation that a participating corporation wishes to meet. Accordingly before joining the group, the participating corporations are aware of each other. In view of the above, Wilens teaches away from the claimed invention and hence it is not possible for Wilens taken alone or combined with any other reference to lead the person skilled in the art to the claimed invention.

It is therefore the view of the Applicant that Wilens taken alone or in combination with McGeachie does make a *prima facie* case of obviousness and thus does not render Claims 42 and 39 obvious.

Reconsideration and withdrawal of this rejection entered under 35 U.S.C. 103(a) as applicable to the amended claims are respectfully requested.

Prompt reconsideration and an early notice of allowance are earnestly solicited.